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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,380	08/27/2003	Yoshiyuki Tamai	325772033000	5365
25227 7590 01/08/2008 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102			EXAMINER PATEL, CHIRAG R	
			ART UNIT 2141	PAPER NUMBER
			MAIL DATE 01/08/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/648,380

Applicant(s)

TAMAI ET AL.

Examiner

Chirag R. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Arguments

Applicant's arguments filed November 7, 2007 have been fully considered but they are not persuasive. Examiner asserts that the 101 rejections are removed. A discussion of the amended claims is provided below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 9, 11-16 and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al. – hereinafter Chang (US 5,974,449).

As per claims 1, 2, 4, 13-14, 16, 21-22, and 24, Chang discloses a recording medium in which a program for making a computer execute processing, the processing, comprising:

detecting a recipient's domain name of an e-mail to be transmitted with data attached to the e-mail from a recipient's address of the e-mail; detecting a recipient's server based on the detected recipient's domain name; (Col 17 line 1 – Col 18 line 8, Figure 14)

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detecting a response time of the detected recipient's server; (Col 7 line 62 – Col 8 line 11, functionality of 'ping')

deciding a format of the data to be attached to the e-mail depending on the detected response time; (Col 17 lines 40-45, Fig. 14: item 1414)

formatting the data into the decided format; (Col 17 lines 1 – Col 18 line 18)

attaching the formatted data as an attachment to the e-mail; and (Col 11 lines 53-59, Col 17 lines 15-27)

and transmitting the data formatted into the decided format to the recipient's address as an attachment of the e-mail. (Col 17 line 1 – Col 18 line 8)

As per claims 3, 15, and 23, Chang discloses a recording medium in which a program for making a computer execute processing, the processing, comprising:

receiving a transmission instruction of an e-mail to be transmitted with data attached to the e-mail: detecting a recipient's domain name of the e-mail from a recipient's address of the e-mail based on the received transmission instruction; (Col 17 line 1 – Col 18 line 8, Figure 14)

detecting a recipient's server based on the detected recipient's domain name;

searching a route to the detected server; (Col 17 line 1 – Col 18 line 8)

discriminating whether a relay server having a prescribed property exists on the detected route; (Col 17 line 1 – Col 18 line 8)

deciding a format of the data to be attached to the e-mail depending on the discriminated result; (Col 17 line 1 – Col 18 line 8)

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formatting the data into the decided format; (Col 17 line 1 – Col 18 line 8)

attaching the formatted data as an attachment to the e-mail; and (Col 11 lines 53-59, Col 17 lines 15-27)

and transmitting the data formatted into the decided format to the recipient's address as an attachment of the e-mail. (Col 17 line 1 – Col 18 line 8)

As per claim 9, Chang discloses the recording medium as recited in claim 1, wherein the program stored in the recording medium makes the computer discriminate whether the recipient belongs to the same organization of a sender based on the detected recipient's domain name and decide a format of the data to be attached to the e-mail based on the discriminated result. (Col 17 lines 40-45)

As per claims 11, 12, and 19-20 Chang discloses the recording medium as recited in claim 2, wherein the response time is detected by executing a connection status searching command against the detected server. (Col 7 line 62 – Col 8 line 11, functionality of 'ping')

As per claim 18, Chang discloses the e-mail transmission apparatus as recited in claim 13, further comprising an original document reading apparatus to obtain image data by reading an original document, wherein the image data read by the original

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document reading apparatus is transmitted as attached data of the e-mail. (Col 1 lines 42-52)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 5,974,449) in view of Mai et al. (US 2006/0242311).

As per claims 5-8 and 17, Chang discloses the recording medium as recited in claim 1 the program stored in the recording medium makes the computer decide the format of the data every recipient and format the data into respective decided formats. (Col 17 line 1 – Col 18 line 8) Chang fails to disclose where the data is transmitted simultaneously to a plurality of recipients. Mai discloses where the data is transmitted simultaneously to a plurality of recipients. ([0010]) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to where the data is transmitted simultaneously to a plurality of recipients in the disclosure of Chang. The motivation for doing so would have been to deliver IP multicast content to users via a non-multicast enabled network. ([0007])

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 5,974,449) in view of Dunnion et al. – hereinafter Dunnion (US 2002/0199119).

As per claim 10, Chang discloses the recording medium as recited in claim 9, wherein, in cases where it is discriminated that the recipient belongs to an organization different from an organization of the sender. (Col 17 lines 40-45) Chang fails to disclose the program stored in the recording medium makes the computer format the data into a format which is more difficult to edit the data than a format which is used to transmit the data to the same organization. Dunnion discloses the program stored in the recording medium makes the computer format the data into a format which is more difficult to edit the data than a format which is used to transmit the data to the same organization. ([0123], Table 4, Mail Commands, "Convert form MIME format into proprietary format for efficient transmission." At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to format the data into a format which is more difficult to edit the data than a format which is used to transmit the data to the same organization in the disclosure of Chang. The motivation for doing do would have been to provide for improved security for email communication. ([0027])

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag R Patel whose telephone number is (571)272-7966. The examiner can normally be reached on Monday to Friday from 7:30AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharja, can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197


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